

Remarks

Claims 1 to 24 are pending. No claims have been amended or canceled.

§ 102 Rejections

Claims 1, 2, 23 and 24 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Pat. No. 5,380,046 to Stephens (hereinafter "Stephens"). The Examiner asserted that "Stephens discloses all of the subject matter as set forth in the claims and is identical to the invention as broadly recited. Some of the claimed elements clearly disclosed by the reference are: a security feature (16), a transparent fragile layer (12') and a transparent durable layer (12')." Applicants respectfully traverse the rejections as follows.

Claim 1

Applicants respectfully submit that Stephens fails to teach all of the elements recited in claim 1. In support of this, Applicants respectfully repeat the arguments presented in response to the Office Action dated 7 October, 2003.

In addition, the Examiner in the Final Office Action further asserts that:

. . . the features upon which applicant relies are very broadly presented (i.e., fragile layer, durable layer, security element etc.) and are not positively recited with significant structure in the rejected claim(s) to distinguish over the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicants respectfully traverse each of these assertions as follows.

The Examiner's asserts that ". . . the features upon which applicant relies are very broadly presented (i.e., fragile layer, durable layer, security element etc.) and are not positively recited with significant structure in the rejected claim(s) to distinguish over the prior art." Applicants respectfully submit that the claims must be interpreted as broadly as their terms will reasonably allow. This means that the words of the claim must be given their plain meaning unless

applicant has provided a clear definition in the specification. *In re Zletz*, 903 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In claim 1, Applicants recite a transparent data sheet that includes, besides other things, both a transparent durable layer and a transparent fragile layer that are laminated together. Applicants positively recite the adjective "durable" to describe one transparent layer and a different adjective "fragile" to describe another transparent layer. In addition, Applicants provide a clear definition of the terms "durable" and "fragile" (see, for example, page 2, lines 24-30). As such, one skilled in the art would appreciate that these two different layers have been broadly and positively recited with significant structure.

As for distinguishing over Stephens with this significant structure, Applicants respectfully submit Stephens fails to teach, besides other things, both the transparent durable layer and the transparent fragile layer, as recited in claim 1. Rather, Stephens teaches that the "plastic envelope 12 comprises dual rectangular plies 12', 12" of a transparent thermoplastic material" is rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack or bookbag [*sic*], etc." (Col. 3, lines 7-27). Stephens even provides that the information packet includes a "cutting line or lines along which to open the packet, e.g., by the use of scissors as shown in FIG. 4, to obtain access to the information." (Col. 3, lines 35-41). In contrast, Applicants define the term "fragile" in the "transparent fragile layer" to mean "a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26). Applicants respectfully submit that Stephens fails to teach such a layer. As such, Stephens fails to teach both a transparent durable layer and a transparent fragile layer, as recited in claim 1.

The Examiner further asserts that "[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)." Applicants respectfully submit that the "limitations" are positively recited in claim 1, and not being read in from the specification. In other words, limitations from the specification are not being read into claim 1, as claim 1 positively recites the limitations (e.g., claim 1 recites a transparent data sheet that includes, besides other things, a transparent durable layer and a transparent fragile layer).¹

¹ M.P.E.P. 2145 provides that in *In re Gorman* the "[c]laims to a superconducting magnet which generates a 'uniform magnetic field' were not limited to the degree of magnetic field uniformity required for Nuclear Magnetic Resonance (NMR) imaging. Although the specification disclosed that the claimed magnet may be used in an NMR

Finally, the Examiner indicates that "... it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte* Masham, 2 USPQ2d 1647 (1987)" Applicants respectfully submit that, as discussed above, Stephens fails to teach all the "structural limitations" recited in claim 1. As such, no issue as to how the claimed apparatus is to be employed even arises (*i.e.*, since Stephens fails to teach all the apparatus elements no issue of how the apparatus is to be employed even arises).

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claim 1 is not taught in Stephens. Therefore, the § 102 rejection should be withdrawn.

Claim 2

Applicants respectfully submit that Stephens fails to teach all of the elements recited in claim 2. In support of this, Applicants respectfully repeat the arguments presented in response to the Office Action dated 7 October, 2003.

As for the Examiner's response to Applicants' arguments, presented above in the discussion of claim 1, Applicants respectfully traverse each of these assertions as follows.

The Examiner's asserts that "... the features upon which applicant relies are very broadly presented (*i.e.*, fragile layer, durable layer, security element etc,) and are not positively recited with significant structure in the rejected claim(s) to distinguish over the prior art." Applicants respectfully submit that the claims must be interpreted as broadly as their terms will reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 903 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In claim 2, Applicants recite a transparent data sheet that includes, besides other things, a transparent fragile layer and a second transparent fragile layer, where the two layers are laminated together to form a laminate, wherein the laminate is durable. Applicants positively

apparatus, the claims were not so limited." So it appears that in *Gorman* specific limitations for the degree of magnetic field required for NMR imaging were not expressly recited in the claims, but rather were trying to be read into the claims. In contrast, Applicants are not trying to read any additional limitations into what is already being recited in the claims.

recite the adjective "fragile" to describe the two transparent layers and a different adjective "durable" to describe the laminate. In addition, Applicants provide a clear definition of the terms "durable" and "fragile" (see, for example, page 2, lines 24-30). As such, one skilled in the art would appreciate that these two layers and the laminate have been broadly and positively recited with significant structure.

As for distinguishing over Stephens with this significant structure, Applicants respectfully submit Stephens fails to teach, besides other things, "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. Applicants use the term "fragile" in the "transparent fragile layer" and the "second transparent fragile layer" to mean "a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26). Applicants respectfully submit that Stephens fails to teach such a layer. Rather, Stephens teaches that the "plastic envelope 12 comprises dual rectangular plies 12', 12" of a transparent thermoplastic material" is rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack of bookbag [*sic*], etc." (Col. 3, lines 7-27). Stephens even provides that the information packet includes a "cutting line or lines along which to open the packet, e.g., by the use of scissors as shown in FIG. 4, to obtain access to the information." (Col. 3, lines 35-41). As such, Stephens fails to teach both "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2.

The Examiner further asserts that "[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)." Applicants respectfully submit that the "limitations" are positively recited in claim 2, and not being read in from the specification. In other words, limitations from the specification are not being read into claim 2, as claim 2 positively recites the limitations (e.g., claim 2 recites a transparent data sheet that includes, besides other things, a transparent fragile layer and a second transparent fragile layer).²

Finally, the Examiner indicates that " . . . it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte* Masham, 2 USPQ2d 1647 (1987)" Applicants respectfully submit that, as discussed above,

Stephens fails to teach all the "structural limitations" recited in claim 2. As such, no issue as to how the claimed apparatus is to be employed even arises (*i.e.*, since Stephens fails to teach all the apparatus elements no issue of how the apparatus is to be employed even arises).

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claim 2 is not taught in Stephens. Therefore, the § 102 rejection should be withdrawn.

Claims 23 and 24

Applicants respectfully submit that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency in rejecting claims 23 and 24. In addition, Stephens fails to teach all of the elements recited in claims 23 and 24. In support of these statements, Applicants respectfully repeat the arguments presented in response to the Office Action dated 7 October, 2003.

In addition, the Examiner in the Final Office Action further asserts that:

In regard to applicant's arguments with respect to claims 23 and 24, once again the features upon which applicant relies are very broadly presented (*i.e.*, fragile layer, durable layer, security element etc.) and are not positively recited. It is clear from Stephens disclosure that the method recited by applicant is substantially similar to the assembly steps of the Stephens device. Applicant's attention is directed to column 2, lines 1-23.

Applicants respectfully traverse each of these assertions as follows.

The Examiner's asserts that "... the features upon which applicant relies are very broadly presented (*i.e.*, fragile layer, durable layer, security element etc.) and are not positively recited." Applicants respectfully submit that the claims must be interpreted as broadly as their terms will reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 903 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

In claim 23, Applicants recite a process for manufacturing a transparent data sheet that includes, besides other things, providing a printable surface of a first fragile layer and providing

² Applicants respectfully repeat the description and comments regarding M.P.E.P. 2145 and *In re Gorman* presented

a second layer, which is a durable layer or is a fragile layer, wherein the combination of the first and second layer provide a durable sheet. In claim 24, Applicants recite a process of manufacturing a transparent data sheet that includes printing identification information onto a surface of a first layer and laminating the printed surface of the first layer to another layer, wherein both layers are optically transparent and one layer is more fragile than the other. Applicants positively recite the adjective "fragile" to describe one layer and a different adjective "durable" to describe another layer. In addition, Applicants provide a clear definition of the terms "durable" and "fragile" (see, for example, page 2, lines 24-30). As such, one skilled in the art would appreciate that these two different layers have been broadly and positively recited with significant structure.

The Examiner then asserted that "[i]t is clear from Stephens disclosure that the method recited by applicant is substantially similar to the assembly steps of the Stephens device. Applicant's attention is directed to column 2, lines 1-23." Applicants respectfully traverse this assertion.

Applicants respectfully submit Stephens fails to teach, besides other things, a process for manufacturing a transparent data sheet that includes, besides other things, providing a printable surface of a first fragile layer and providing a second layer, which is a durable layer or is a fragile layer, wherein the combination of the first and second layer provide a durable sheet, as recited in claim 23. As discussed above for claims 1 and 2, Stephens teaches two durable plies of the envelope 12, but fails to teach a first fragile layer and a second layer, which is a durable layer or is a fragile layer, wherein the combination of the first and second layer provide a durable sheet, as provided in claim 23. As a specific example, Stephens fails to teach a "fragile layer," as recited in claim 23.

In addition, Applicants respectfully submit Stephens fails to teach, besides other things, a process of manufacturing a transparent data sheet that includes printing identification information onto a surface of a first layer and laminating the printed surface of the first layer to another layer, wherein both layers are optically transparent and one layer is more fragile than the other. As discussed above for claims 1 and 2, Stephens teaches two durable plies of the envelope 12, but fails to teach that one ply is "more fragile than the other." Rather, Stephens teaches that the "plastic envelope 12 comprises dual rectangular plies 12', 12" of a transparent thermoplastic

above in footnote 1.

material" is rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack or bookbag [*sic*], etc." (Col. 3, lines 7-27). Stephens fails, however, to teach that the plies have dissimilar properties. As such, Stephens fails to teach all the elements recited in claim 24.

As such, each and every element of independent claims 23 and 24 are not taught in Stephens. Therefore, the § 102 rejection should be withdrawn.

Reconsideration and withdrawal of the § 102 rejection for the above independent claims, as well as those claims which depend therefrom, are respectfully requested.

§ 103 Rejections

Claims 9, 12 and 13

Claims 9, 12 and 13 stand rejected under 35 USC § 103(a) as being unpatentable over Stephens. Applicants respectfully traverse the rejection as follows.

As discussed above, Stephens fails to teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. Stephens also fails to teach or suggest "at least one security element," as recited in claims 1 and 2. In addition, Stephens fails to teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens. As claims 9 and 13 are dependent claims of independent claims 1 and 2, and claim 12 is a dependent claim of independent claim 1, the §103 rejection of claims 9, 12 and 13 should be withdrawn.

The rejection of claims 9, 12 and 13 under 35 USC § 103(a) as being unpatentable over Stephens has been overcome and should be withdrawn. Reconsideration and withdrawal of the § 103 rejection for claims 9, 12 and 13 are respectfully requested.

Claims 3 and 5

Claims 3 and 5 stand rejected under 35 USC §103(a) as being unpatentable over Stephens in view of U.S. Pat. No. 5,342,672 to Killey. Applicants respectfully traverse the rejection as follows.

As discussed above, Stephens fails to teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. Stephens also fails to teach or suggest "at

least one security element," as recited in claims 1 and 2. In addition, Stephens fails to teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens.

The Examiner cited Killey to illustrate a holographic thermal transfer ribbon. Killey, however, does not cure the above identified deficiencies of Stephens. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens and Killey, either independently or in combination. As claims 3 and 5 are dependent claims of independent claims 1 and 2, the § 103 rejection of claims 3 and 5 should be withdrawn.

The rejection of claims 3 and 5 under 35 USC § 103(a) as being unpatentable over Stephens in view of Killey has been overcome and should be withdrawn. Reconsideration and withdrawal of the § 103 rejection for claims 3 and 5 are respectfully requested.

Claims 4, 6-8, 10, 11, 14-21

Claims 4, 6-8, 10, 11, 14-16 and 19-21 stand rejected under 35 USC §103(a) as being unpatentable over Stephens in view of U.S. Pat. No. 4,968,063 to McConville et al. Claims 17 and 18 stand rejected under 35 USC §103(a) as being unpatentable over Stephens in view of McConville and Killey. Applicants respectfully traverse the rejection as follows.

As discussed above, Stephens fails to teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. In addition, Stephens fails to teach or suggest "at least one security element," as recited in claims 1 and 2. Stephens also fails to teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens.

As claims 4, 6-8 and 19 are dependent claims of independent claims 1 and 2; claims 10, 11, 14, 16 and 18 are dependent claims of independent claim 1; claims 15 and 17 are dependent claims of independent claim 2; and claims 20 and 21 recite claims 1 and 2 as an element, the §103 rejection of claims 4, 6-8, 10, 11, 14-21 should be withdrawn.

The rejection of claims 4, 6-8, 10, 11, 14-16 and 19-21 under 35 USC § 103(a) as being unpatentable over Stephens in view of McConville et al. has been overcome and should be withdrawn. In addition, the rejection of claims 17 and 18 under 35 USC § 103(a) as being

unpatentable over Stephens in view of McConville and Killey has been overcome and should be withdrawn.

Reconsideration and withdrawal of the § 103 rejection for claims 4, 6-8, 10, 11, 14-21 are respectfully requested.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and allowance of the pending claims is respectfully requested.

The Examiner is invited to telephone the applicant's below signed attorney or Melissa E. Buss, Esq. at (651) 733-0649 to facilitate prosecution of this application.

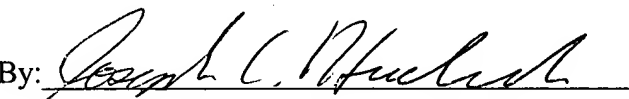
At any time during the pendency of this application, please charge any additional fees or credit any overpayment to Deposit Account No. 13-3723.

Respectfully submitted,

September 1, 2004

Date

By:



Joseph C. Huebsch, Reg. No.: 42,673

Telephone No.: (612) 659-9340

E.J. Brooks & Associates, PLLC
1221 Nicollet Avenue, Suite 500
Minneapolis, MN 55403